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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,485

12/05/2003

Cynthia L. Wyngaard

19,525

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07/26/2006

KIMBERLY-CLARK WORLDWIDE, INC.  
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NEENAH, WI 54956

EXAMINER

BOGART, MICHAEL G

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/729,485	WYNGAARD, CYNTHIA L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael G. Bogart	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections – 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-5, 8, 11, 16-19 and 26-28 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Jitoe *et al.* (US 2002/0151862 A1; hereinafter “Jitoe”).

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Regarding claims 1 and 26, Jitoe teaches an absorbent article (1) defining a front waist region (6), a back waist region (7), a crotch region (8) that extends between and connects said front and back waist regions (6, 7), a longitudinal direction and a lateral direction, an inner surface, an outer surface opposite said inner surface, and a pair of longitudinally opposed end margins and a pair of laterally opposed side margins, said article (1) comprising:

A stretchable outer cover (3);

A stretchable bodyside liner (2) joined to the stretchable outer cover (3) in a superposed relation wherein said outer cover (3) and said bodyside liner (2) are joined (13) along at least a portion of each of said end margins to provide a front waist seam and a back waist seam and wherein said outer cover (3) and said bodyside liner (2) are joined (13) along at least a portion of each of said side margins in said front waist region (6) and said back waist region (7) to provide a pair of side seams in each of said front waist region (6) and said back waist region (7);

An absorbent body (4) disposed between said outer cover (3) and said bodyside liner (2), said absorbent body (4) defining a pair of longitudinally opposed absorbent end edges (22) and a pair of laterally opposed absorbent side edges (23);

A first left elastomeric suspension member (21B) disposed only in said front waist region (6) and attached to said absorbent body (4) in said front waist region (6); and

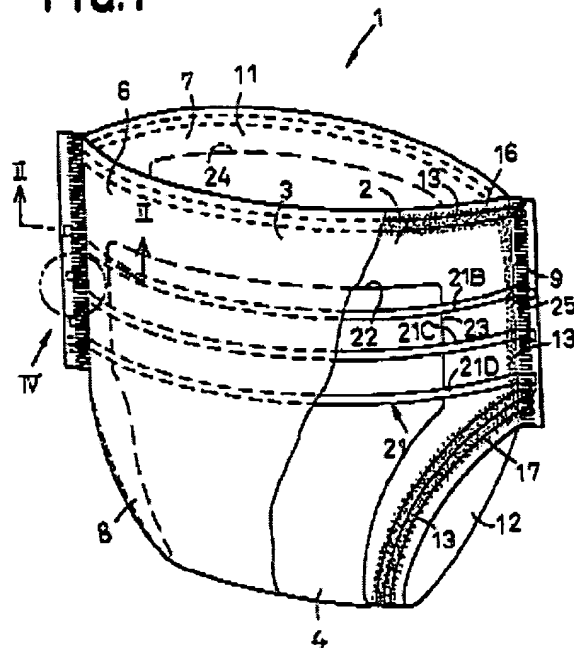
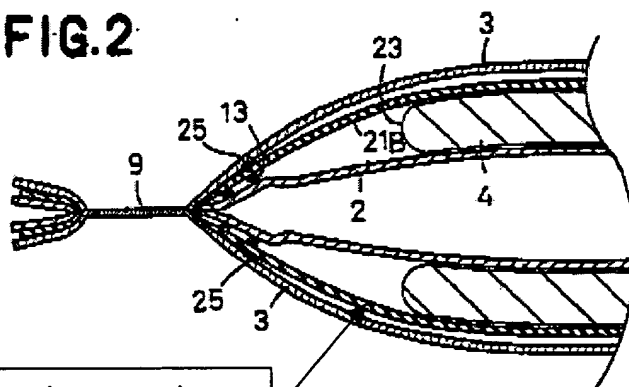
A second right elastomeric suspension member attached to said absorbent body (4) in said back waist region (7);

Wherein said first elastomeric suspension member (21B) is sandwiched between said outer cover (3) and said bodyside liner (2) in said pair of side seams in said front waist region (6), and wherein said second elastomeric suspension member is sandwiched between said outer

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cover (3) and said bodyside liner (2) in said pair of side seams in said back waist region

(7)(paragraphs 0026-0028)(see annotated figures 1 and 2, infra).

**FIG. 1****FIG. 2**

2<sup>nd</sup> elastomeric suspension member

Regarding the recited stretchability of the outer cover and body side liner, these layers are interpreted herein as being inherently stretchable because they are constructed of thermoplastics which are inherently stretchable or deformable to some degree, especially when heat is applied.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. §§ 102 and 103, expressed as a 102/103 rejection. “There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. § 103 and for anticipation under 35 U.S.C. § 102.” *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. § 102/103 rejection is appropriate for these types of claims as well as for composition claims.

“[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, supra.

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003).

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. § 102, on prima facie obviousness’ under 35

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U.S.C. § 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, supra). MPEP § 2112.

Regarding claims 16, 18 and 27, Jitoe teaches that the absorbent body (4) is configured to float between the outer cover (3) and the bodyside liner (2)(see figure 2, supra).

Regarding claim 2, Jitoe teaches that the first suspension member (21B) defines a first suspension member width in said lateral direction that is substantially equal to an article width in said front waist region (6) and said second suspension member defines a second suspension member width in said lateral direction that is substantially equal to an article width in said back waist region (7)(figure 1).

Regarding claims 3, Jitoe teaches that said first suspension member (21B) is sandwiched between said outer cover (3) and said bodyside liner (2) in said front waist seam (figure 1).

Regarding claims 4, Jitoe teaches that said second suspension member is sandwiched between said outer cover (3) and said bodyside liner (2) in said rear waist seam (figure 1).

Regarding claims 5, 19 and 28, Jitoe teaches that the suspension members (21B) are constructed of materials that are inherently biaxially stretchable (paragraph 0032).

Regarding claim 8, Jitoe teaches that a portion of each of the suspension members (21B) are longitudinally aligned with part of the absorbent member (4)(figure 1).

Regarding claim 11, Jitoe teaches an absorbent body that is hourglass-shaped (figure 1).

Regarding claim 17, Jitoe teaches that the absorbent body (4) is disposed toward the inner surface relative to the suspension members (figure 2).

***Claim Rejections – 35 USC § 103***

Claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 33 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Jitoe.

Jitoe is silent as to the specific elongatability of the suspension members, outer cover or bodyside liner. As discussed supra, the materials disclosed in Jitoe are inherently elongatable thermoplastics.

Differences in functional test or performance characteristics will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such test characteristic is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Regarding claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 33, the benefits of optimizing the elongatability of the suspenders or other layers would have been known prior to applying a test, making these values result-effective variables. One of ordinary skill in the art would have recognized that increasing elongatability increases the ability of the finished product to withstand stresses that may be encountered during use. MPEP § 2144.04.



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Claims 9, 10, 12, 14, 21, 22, 24, 30 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jitoe as applied to claims 1-5, 8, 11, 16-19 and 26-28, above, and further in view of Osborn, III *et al.* (US 5,713,884 A).

Jitoe does not expressly disclose elastic outer covers, bodyside liners or absorbent bodies.

Osborn, III *et al.* teach an absorbent article having elastic topsheets and absorbent cores (col. 18, lines 15-49; col. 26, lines 35-50).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the elastic body liner and core of Osborn, III *et al.* with the article of Jitoe *al.* in order to provide an article that will comfortably conform to the anatomy of a wearer.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Bogart  
18 July 2006

TATYANA ZALUKAEVA  
SUPERVISOR, PRIMARY EXAMINER  
